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**NOTICE OF APPEAL FROM THE EXAMINER TO
THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Docket Number (Optional)

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Signature

Typed or printed name

Anthony I. Provitola

In re Application of

Anthony I. Provitola

Application Number

09/536,625

Filed

March 28, 2000

For

SYSTEM OF SECRET INTERNET WEB
SITES FOR SECURING USER ACCESS

Art Unit

2131

Examiner

Arezoo Sherkat

Applicant hereby appeals to the Board of Patent Appeals and Interferences from the last decision of the examiner.

The fee for this Notice of Appeal is (37 CFR 41.20(b)(1))

\$ 340.00☒ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is:\$ 170.00☐ A check in the amount of the fee is enclosed.☒ Payment by credit card. Form PTO-2038 is attached.☐ The Director has already been authorized to charge fees in this application to a Deposit Account. I have enclosed a duplicate copy of this sheet.☐ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. _____ I have enclosed a duplicate copy of this sheet.☐ A petition for an extension of time under 37 CFR 1.136(a) (PTO/SB/22) is enclosed.**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

I am the

☒ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☐ attorney or agent of record.
Registration number _____☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34. _____

Signature

Anthony I. Provitola

Typed or printed name

Telephone number _____

November 3, 2004

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.☐ *Total of _____ forms are submitted.

This collection of information is required by 37 CFR 41.31. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Serial Number 09/536,625

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Board of Patent Appeals and Interferences

Applicant : Anthony I. PROVITOLA
Serial Number : 09/536,625
Filed : March 28, 2000
For : SYSTEM OF SECRET INTERNET WEB SITES FOR SECURING
USER ACCESS
Examiner : Arezoo Sherkat
Group Art Unit : 2131
Date : November 3, 2004

Honorable Commissioner of Patents
Post Office Box 1450
Alexandria, Virginia 22313-1450

Sir:

Brief on Appeal

This is Appellant's Brief on Appeal from the final rejection dated August 4, 2004 of claims 1 through 20. The fee of \$170.00 for filing this Brief pursuant to 37 CFR 1.17(f) has been paid by Credit Card Authorization filed with this Brief. Appellants waive an Oral Hearing for this appeal.

I. Real Party In Interest

The Real Party in Interest in this Appeal is Anthony I. Provitola, Applicant and Inventor.

II. Related Appeals and Interferences

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There are no related appeals or interferences.

III. Status of the Claims

Claims 1-20 are rejected under 35 U.S.C. 103(a). Claims 1-20 are hereby appealed.

IV. Status of Amendments

An amendment to claims 1, 14, and 20 was filed on May 24, 2004, and was entered and considered.

Claims 1-20, all the claims in the Application considered by the Examiner, remain rejected.

V. Summary of the Invention

The invention is directed to a system of secret internet sites and an internet operation including such a system. The invention is used to permit access to a particular internet operation by persons intending to make normal use thereof when access to the internet operation's publicly known internet site has been compromised by cybervandalism. This is accomplished by designation by an internet site operator of specific alternative internet sites which are secret and have been assigned for the use of specific users who have previously identified themselves to that internet site operator. Such a user's access to a particular internet operation is thus secured when that internet operation's publicly known site is under a cybervandalism attack, such as a denial-of-service attack.

VI. Issues

The issue for review is as follows:

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Whether claims 1-20 are unpatentable under 35 U.S.C. 103(a) over the combined teachings of Baker (U.S. Patent No. 5,961,645 and Baker hereinafter) and Smith, et al., (U.S. Patent No. 6,529,956 and Smith hereinafter).

VII. Grouping of Claims

Claims 1-13 are considered together; claims 14-19 are considered together; and claim 20 is considered by itself.

VIII. Argument

Before presenting the patentability arguments, a brief description of the references relied upon by the Examiner is set forth follows:

1. Baker. Baker discloses methods and systems for “filtering for public databases with naming ambiguities”, but is not referred to by the Examiner for any particular of the disclosure therein: Baker is referred to only for its statement of the “background of the invention” as the prior art of internet operations generally.

2. Smith. Smith discloses a “document delivery architecture” which generates a “private Uniform Resource Locator (URL), referred to as a “PURL” in the lexicon of the disclosure, to distribute information, which uniquely identifies an intended recipient of one or more documents. The “PURL” referred to in Smith is disclosed as incorporating only the URL of the single internet site of the internet operation which is delivering the documents, and is generated by adding extensions to that URL which are particular to the user of that site and for whom the documents are

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intended.

In this regard it is to be emphasized that Baker is not cited as a reference for any *invention* disclosed in Baker, but *only* for the general features common to every internet operation. Therefore, by reason of the very nature of such a reference, motivation can not possibly be found for any modification or combination, let alone motivation to modify by incorporating “secret sites”, as defined in the second and fourth paragraphs of the “Detailed Description of the Invention” of the present Application. The Examiner’s obviousness rejection, being thus completely dependent on specific features of Smith, appears to be an attempt to disguise what would be a patently erroneous anticipation rejection based on the Smith reference under Section 103(a). It is fundamental that had the Examiner found that an anticipation rejection based on Smith was proper, the Examiner was duty bound to make such a Section 102 rejection in said office action. It is clear that the Examiner could not find such a Section 102 rejection to be appropriate.

Claims 1-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Baker and Smith.

It is to be noted in Office Action mailed on August 4, 2004, from which this appeal is taken, that the Examiner in rejecting each independent claim (1, 14, and 20):

- 1) admits that Baker does not disclose the present invention, the column and line references to Baker being only to the Background of the Invention in Baker, which refers only to internet operations generally;
- 2) alleges, without any stated reason, the column and line reference to Smith notwithstanding, that Smith discloses the present invention by equating the term “secret sites” with the term “Private

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URL” used in Smith et al.; and

3) concludes only:

(a) *without any stated reason*, that it would have been obvious to a person of ordinary skill in the art to modify the teachings of Baker with the teachings of Smith; and

(b) *without stating any relation to the present invention*.

As indicated earlier in this Brief, there is no line of reasoning by the Examiner in any form to demonstrate the motivation for the modification of the general teachings of Baker with the teachings of Smith by an artisan of *any* level of skill. The Examiner’s standard for determining a *prima facie* case of obviousness, as indicated by said Office Action”, permits the Examiner to *select a mere aggregate* of references which are not associated by any form of suggestion, and which do not even contain the concepts and terms that are used in the present disclosure, as components for a *prima facie* case, without *any* rationale from those references or scientific principle as to why they should be combined to produce the present invention. Indeed, even if the mere fact that references can be combined or modified does not render the resultant combination obvious *unless the prior art also suggests the desirability of the combination*. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). A statement that modifications of the prior art to meet the claimed invention would have been within the ordinary skill of the art because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levensgood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

To establish a *prima facie* case of obviousness three basic criteria must be met: the first is

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that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). This is the standard that was stated in slightly different terms in *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985): "To support the conclusion that the claimed invention is directed to obvious subject matter, either *the references must expressly or impliedly suggest* the claimed invention or the *examiner must present a convincing line of reasoning* as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references (emphasis supplied)." Not only are neither of the alternative grounds emphasized in the quotation of *Ex Parte Clapp* validly possible from the references applied to the present disclosure, but neither of the alternative grounds are present in said Office Action *at all*. There is no suggestion whatever in Baker, express or implied, for the use of the features of Smith, and there is no line of reasoning by the Examiner in any form as to how the teachings *actually present* in Baker would be modified by the teachings of Smith by an artisan of *any* level of skill.

A. Claim 14 is the broadest claim for the system of secret internet sites which are operated to provide alternative access to internet operations whose internet sites are publicly known. The principal feature of the system are the secret internet sites that have universal resource locators (URLs) which are not publicly associated with any internet operation, but which provide alternative access to a publicly known internet operation using the system.

No matter how the Baker and Smith are analyzed or parsed into elements, the combination

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of the two references do not, even as a grab bag of elements, provide physically or conceptually what is necessary to practice the invention. Following the admission that “Baker does not expressly disclose Internet operation including a system of secret internet web sites”, the Examiner supports this Section 103(a) obviousness rejection with the following allegation:

“However, Smith discloses Internet operation including a system of secret internet web sites comprising:

one or more of said internet web sites being secret sites having URLs which are not publicly associated with said internet operation (i.e., Private URL), said secret sites being a part of said internet operation by which said internet operation may be accessed (Col. 15, lines 22-67).”

In fact Smith does not disclose as alleged by the Examiner. What Smith **actually** discloses with regard to the use of the term “PURL” is as follows (referred to as “Disclosures” for the purpose of reference thereto hereinafter):

(Disclosure 1): “An electronic document delivery system and methods of its use are provided. A document delivery architecture dynamically generates a private Uniform Resource Locator (URL) to distribute information. Each private URL (“PURL”) uniquely identifies an intended recipient of a document, the document or set of documents to be delivered, and (optionally) other parameters specific to the delivery process. The intended recipient of a document uses the PURL to retrieve the document.” (Smith: Col. 2, Lines 28-35)

(Disclosure 2): “The invention provides a document delivery architecture which dynamically generates a private Uniform Resource Locator (URL) to distribute information. Each private URL (“PURL”) uniquely identifies the intended recipient of a document, the document or set of

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documents to be delivered, and (optionally) other parameters specific to the delivery process. The intended recipient of a document uses the PURL to retrieve a document (or documents).” (Smith: Col. 14, Lines 49-62)

(Disclosure 3): “PURLs are temporary, dynamically generated uniform resource locators which uniquely identify the intended recipient of a document and the document itself, as well attributes associated with the delivery of a document.” (Smith: Col. 15, Lines 22-29, *emphasis supplied*)

(Disclosure 4): “The server dynamically generates a URL for each intended recipient of the document.” (Smith: Col. 15, Lines 46-48)

(Disclosure 5): “PURL Implementation”

“First, consider the potential construction of a PURL. The following diagram

outlines one specific example of a PURL:

“http://posta.tumbleweed.com/cgi/posta.dll?pu=0-233-33982-FIAAAV4

“The above PURL denotes the following:

“Value	Meaning
“http:/	Use the HTTP protocol to access.
“posta.tumbleweed.com	Name of the HTTP server.
“cgi/posta.dll	Name of HTTP server extension.
“pu=O	Don't use a password.
“233	Store item Identifier.
“33982	Recipient Identifier.
“FIAAAV4	Key to access the document.”

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(Smith: Col. 16, Lines 36-51, *emphasis supplied*)

Disclosures 1-4 describe “PURL” as uniquely identifying one or more specific documents and the intended recipient thereof, and do not teach the secrecy of any internet site. Disclosure 5, in describing the construction of a “PURL”, teaches only a system of variation in the extension of the URL for the publishing internet site, and **not** the use of a different and secret internet site identified by a completely different URL. In this latter respect it should be noted that the Applicant is not bound by terminology used and defined in another patent for a feature which is peculiar to that patent (“PURL” in Smith), or by the potentially confusing use of a term (URL in Smith). The term URL stands for universal resource locator, which is the way in which an internet site is identified, much as a telephone number identifies a telephone line. The URL is **not** the internet site *as such*, just as a telephone number is **not** the telephone line *as such*. (See “Harley Hahn Teaches the Internet”, copyrighted in 1999 (by Harley Hahn and published by Que Coroporation, Library of Congress Catalog Card Number 97-81381; at pages 5 and 6; or any text on the internet.). It is clear that the Smith teaching of “PURLs” as constructed by extensions to a URL for a *particular* internet site does not, even remotely, imply the possibility of different internet sites whose identity are maintained as secret for any purpose, the attempt by the Examiner (pages 4-12 of said office action) to equate irrelevant features of Smith to the “secret internet sites” of the present invention notwithstanding: “private” means belonging to some particular person, not secrecy. Actually Smith’s teaching appears to be to the contrary by referring to the construction of PURLs from the URL for a single internet site.

The Examiner’s analysis in this case must begin with the first two of the four factual inquires

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enunciated *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966) as a background for determining *prima facie* obviousness: determination of the scope and contents of the prior art; and ascertainment of the differences between the prior art and the claims in issue. It is respectfully suggested that the Examiner has failed to properly ascertain the background for carrying out any test for *prima facie* obviousness as required by the Graham factual inquiries with respect to Baker and Smith, and therefore any such determination of *prima facie* obviousness lacks the proper predicate in any event. Simply put none of the foregoing references relied upon severally or combined cannot suggest the invention of described in claim 14.

The foregoing discussion adequately sets forth the reasons why the application of the Barker and Smith references cannot render the present claim 14 unpatentable. For all of the reasons set forth above reversal of the rejection to claim 14 is respectfully requested.

Claims 15-19 depend from claim 14, and are patentable for at least the same reasons as claim 4.

The foregoing discussion adequately sets forth the reasons why the Baker and Smith references cannot render the present claims 15-19 unpatentable. For all of the reasons set forth above reversal of the rejection to claims 15-19 is respectfully requested.

B. Claim 1 is similar to claim 14 by reason of the limitations of claim 4, but with the additional limitation to incorporation. Because claim 1 is narrower by reason of that limitation, claim 1 is patentable for the same reasons as claims 14-19.

Claims 2-13 depend from claim 1, and are patentable for at least the same reasons as claim

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1.

The foregoing discussion adequately sets forth the reasons why the Baker and Smith et al. references cannot render the present claims 1-13 unpatentable. For all of the reasons set forth above reversal of the rejection to claims 1-13 is respectfully requested.

C. Claim 20 is similar to claim 1 by reason of the limitations of claim 14 and further limitation as in claim 1, but with the extensive recitation of the meaning of the term "secret sites" as used in the specification. Because claim 20 is narrower than claim 1 by reason of the limitations associated with the term "secret sites", claim 20 is patentable for the same reasons as claim 1.

The foregoing discussion adequately sets forth the reasons why the Baker and Smith references cannot render the present claim 20 unpatentable. For all of the reasons set forth above reversal of the rejection to claim 20 is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Anthony I. Provitola', enclosed within a large, loopy oval shape.

Anthony I. Provitola,
Applicant

November 3, 2004

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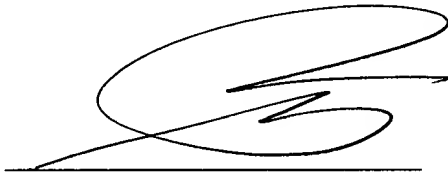
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Anthony I. Provitola

Signature: _____

A handwritten signature in black ink, appearing to be 'A. Provitola', written over a horizontal line.



APPENDIX I
Appealed Claims

Claim 1. An internet operation including a system of secret internet web sites comprising:

- (a) one or more computers programmed to operate as a plurality of web servers;
- (b) one or more of said web servers hosting internet web sites for said internet operation;
- (c) one or more of said internet web sites being main sites having URLs which are publicly associated with said internet operation accessible through said internet web sites;
- (d) one or more of said internet web sites being secret sites having URLs which are not publicly associated with said internet operation;

said secret sites being a part of said internet operation by which said internet operation may be accessed.

Claim 2. The internet operation of Claim 1 wherein the system of secret internet web sites is operated to secure said internet operation against cybervandalism.

Claim 3. The internet operation of Claim 1 wherein the system of secret internet web sites is operated to secure said internet operation against denial-of-service attacks.

Claim 4. The internet operation of Claim 1 wherein one or more of said secret sites are assigned to one or more users of said internet operation.

Claim 5. The internet operation of Claim 1 wherein the URLs of secret sites are maintained as secret by entities authorized by the operator of the internet operation from all but those users who have been given the knowledge thereof by said operator.

Claim 6. The internet operation of Claim 1 wherein the URL of a secret site is acquired by a user through assignment to a user by an entity authorized by the operator.

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Claim 7. The internet operation of Claim 1 wherein a secret site is one whose existence, identity and URL are learned by a user only through the process of subscription.

Claim 8. The internet operation of Claim 1 wherein the user is free to contact and use the main site anonymously as permitted and desired.

Claim 9. The internet operation of Claim 1 wherein a user may subscribe for a secret site URL while the main site is under attack.

Claim 10. The internet operation of Claim 1 wherein the telephone subscription system based on telephone contact is automated to provide a secret site URL.

Claim 11. The internet operation of Claim 1 wherein subscription by a user during an attack is through another internet operation which is independent of the internet operation which includes said main sites.

Claim 12. The internet operation of Claim 1 wherein a reserve of secret sites is maintained that become available to the users of said internet operation in the event of an emergency created by an attack.

Claim 13. The internet operation of Claim 1 wherein the secret site program queries the user for the identification, verifies the information, and proceeds to assign one of the secret site URLs to the user.

Claim 14. A system of secret internet web sites, comprising:

- (a) one or more computers programmed to operate as a plurality of web servers;
- (b) one or more of said web servers hosting internet web sites for an internet operation;
- (c) one or more of said internet web sites being secret sites having universal resource locators (URLs) which are not publicly associated with any internet operation;

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which are operated to provide access to internet operations of other operators of internet web sites.

Claim 15. The system of secret internet web sites of Claim 14 wherein the system of secret internet web sites is operated to secure other internet operations against cybervandalism.

Claim 16. The system of secret internet web sites of Claim 14 wherein the system of secret internet web sites is operated to secure other internet operations against denial-of-service attacks.

Claim 17. The system of secret internet web sites of Claim 14 wherein the URLs of secret sites are maintained as secret by entities authorized by the operator of said system from all but those users who have been given the knowledge thereof by said operator.

Claim 18. The system of secret internet web sites of Claim 14 wherein the telephone subscription system based on telephone contact is automated to provide a secret site URL to subscribing users.

Claim 19. The system of secret internet web sites of Claim 14 wherein a reserve of secret sites is maintained that become available to the users of internet operation served by such a system in the event of an emergency created by an attack.

Claim 20. An internet operation including a system of secret internet web sites comprising:

- (a) one or more computers programmed to operate as a plurality of web servers;
- (b) one or more of said web servers hosting internet web sites for said internet operation;
- (c) one or more of said internet web sites being main sites having URLs which are publicly associated with said internet operation accessible through said internet web sites;
- (d) one or more of said internet web sites being secret sites having URLs which are not publicly associated with said internet operation; wherein each of said secret sites have a URL which:
 - 1. is maintained as a secret from all but those users who have been given the knowledge thereof by the operator; and

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2. is assigned to a user upon the user's request and in response to the user providing means by which they can be sufficiently identified for purposes of the level of security against attack desired by the operator;

and wherein the knowledge of the existence, identity and URL of each of said secret sites is not available to the public except through a process requiring such identification of the user; said secret sites being a part of said internet operation by which said internet operation may be accessed.

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APPENDIX II

References Relied Upon By The Examiner

DOCUMENT

EFFECTIVE DATE

Baker, U.S. Patent No. 5,961,645.....Filed October 1, 1996

Smith, et al., U.S. Patent No. 6,529,956.....Filed March 9, 2000